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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,778	03/04/2004	Chin Sung Ko	MRI197-610	4406
4586	7590	10/27/2005	EXAMINER	
ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043			HAWK, NOAH CHANDLER	
			ART UNIT	PAPER NUMBER
			3637	
DATE MAILED: 10/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/791,778	KO, CHIN SUNG	
	<b>Examiner</b>	<b>Art Unit</b>	
	Noah C. Hawk	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 04 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the "several grooves relating to the balls" as described in the specification. Though these elements are claimed to be shown in Figure 6, it is unclear what the applicant means to disclose. An orthogonal view of the grooves with the runner moved away would be a sufficiently descriptive view, but the cross section shown in Figure 6 is not. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The disclosure is objected to because of the following informalities: on page 1, line 3, the phrase "having the runner" should be "having a runner"; on page 1, line 4 the phrase "at the place" should be "at a place"; on page 1, line 8, the phrase "controlling umbrella frame" should be "controlling the umbrella frame"; on page 1, line 9, the phrase "umbrella at opening state" should be "umbrella at the opened state"; on page 1, line 10, the phrase "within shaft" should be "within the shaft"; on page 1, line 13, the phrase "while it is formed a slot thereon" is nonsense and should be clarified; on page 1, line 14, the phrase "clip user's finger" should be "clip the user's finger"; on page 1, line 17, the phrase "for runner" should be "for the runner"; on page 1, line 19, the phrase "manufactured in ease" should be "manufactured with ease." On page 2, line 15, the phrase "for runner" should be "for the runner." On page 3, line 9, the phrase "to engaging the runner" should be "to engage the runner." It appears that the application is a direct translation of a foreign patent application and contains numerous grammatical and spelling errors. The above list may not be inclusive.

Appropriate correction is required.

***Claim Objections***

3. Claims 1-3 are objected to because of the following informalities: the phrase "for runner" in line 4 should be "for the runner". In line 5, the phrase "a relating ball" should

be “relating balls.” In line 6, the phrase “includes upper” should be “includes an upper.” In line 7, the phrase “having smaller diameter relating to the” should be “having a smaller diameter than the.” In line 10, the phrase “around shaft” should be “around a shaft.” In line 12, the phrase “compressed by middle edge” should be “compressed by the inner middle edge.” In line 13, the phrase “being opened stably” should be “in a safe opened position.” In line 14, the phrase “for runner” should be “for the runner.” In line 17, the phrase “for runner” should be “for the runner.” It appears that the claims are a direct translation of a foreign patent application and contain numerous grammatical and spelling errors. The above list may not be inclusive. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant fails to describe the use of the umbrella runner device of Claim 3 as it is portrayed in Figure 3. When the runner is raised up the umbrella pole, the top lip of the runner (1) will inevitably get caught on the bottom edge of the lower tube (32), thereby

preventing the runner from reaching the gap between the two tubes and rendering the device inoperable.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 3 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. When the runner of Claim 3 is raised up the umbrella pole, the top lip of the runner (1) will get caught on the bottom edge of the lower tube (32), thereby preventing the runner from reaching the gap between the two tubes and rendering the device inoperable.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Katzberg in US Patent 2528002.

a. Regarding Claim 1, Katzberg teaches an engaging structure for the runner of an umbrella including a runner (10, encompassing 16 and 30) provided with

several side apertures (17) for receiving a relating ball (18), a sleeve (20) provided around the runner which includes an upper opening (21) and an inner middle edge (22, the inner surface of the sleeve) having a smaller diameter relative to the opening, and the sleeve having an inner low projective ring (32), which can engage with a positioning ring (31) on the runner thereunder, and the runner with the sleeve being provided around a shaft (12) having an annular convex portion (37).

b. Regarding Claim 2, Katzberg teaches the umbrella runner as claimed in Claim 1, further comprising a shaft (12) provided with several grooves (37, 38) relating to the balls.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Katzberg as applied to claim 1 above. As stated above, Katzberg teaches all of the limitations of claim one including an umbrella runner but does not teach the use of two tubes as an engaging means for the balls. However, the two tubes in interval are merely an obvious variation of the single sleeve with an annular convex portion of Katzberg. The use of two tubes in interval on the shaft serves the same function as the groove taught by

Katzberg: an annular convex portion is formed for receiving the balls, retaining the runner. Further, the shape of the annular convex portion formed by two tubes in interval could be identical to that of a groove machined by a lathe into a shaft by a square-ended cutting tool, and the manufacture of a shaft with two tubes in interval would be easier to accomplish than that of a shaft with an integral groove.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Katzberg in US Patent 2528003, Brandt, Evans, Lin et al., Schafer, Wang and Swiss Publication CH 621691 discloses sliding umbrella runners. McNeal et al. and Sallee disclose sliding locking members for tubular connections. Clothier et al. disclose a tubular connection with grooves to receive a relating ball.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah C. Hawk whose telephone number is 571-272-1480. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NCH *NCH*

10/13/05

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